IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Rose, Jeff Alan et al	§	
	§	Confirmation No.: 5738
Serial No.: 09/915,131	§	
	§	Group Art Unit: 2626
Filed: July 25, 2001	§	
	§	Examiner Shortledge, Thomas E.
For: SYSTEM AND METHOD FOR PROVIDING AUDIBLE OUTPUTS IN A PRE-BOOT ENVIRONMENT IN A COMPUTER SYSTEM	§	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner For Patents
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Responsive to the Final Office Action, dated February 8, 2007, and the Advisory Action dated April 11, 2007, please consider the following remarks in connection with the pre-appeal brief request for review. Review of the final rejection is requested for the following reasons.

1. The rejection of claims 1-3, 6-15, 18-24, and 27-29 is not supported by a *prima facie* case of obviousness.

Claims 1-3, 6-15, 18-24 and 27-29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shin et al (U.S. Patent No. 6,938,152) (Shin hereinafter) in view of Levine et al (U.S. Patent No. 6,732,159) (Levine hereinafter). A *prima facie* case of obviousness is missing and there is no support for an obviousness rejection of the claimed subject matter as a whole because the references fail to disclose each element of the claims or suggest the missing elements.

The final rejection states on page 3 of the Office Action mailed February 8, 2007 that "Shin et al. does not teach a serial speech synthesizer, *detecting the speech synthesizer*, nor the speech synthesizer coupled to the serial port." Emphasis added. In addition the rejection **fails** to show that Levine discloses "*detecting the speech synthesizer.*" To the contrary, the rejection continues that "Levine et al. teach [sp] a speech-synthesizer connected to a serial port, and *recognizing an administration adaptor*, the administration adapter can be a speech synthesizer, (col. 5, lines 27-35, col. 6, 2-6, and col. 12, lines 17-28)." Emphasis added. Applicant submits that none of the referenced sections of Levine teach "*detecting the speech*

synthesizer." For example, 1) col. 5, lines 27-35 states "the administration adaptor 10 is *recognized* [NOT "detected"] by the BIOS 4 as an *MDA* [video monochrome display adapter] *display adapter* [NOT a "speech synthesizer"]"; 2) col. 6, 2-6 makes NO mention of either "detecting", or "speech synthesizer"; and 3) col. 12, lines 17-28 states "[*h*]*aving* [NOT "detecting"] an administration adapter in the system and directing the screen data out the serial port provides a means for the user to get that data to serial speech-synthesis hardware." Emphasis added.

Furthermore, the only references to the word "detect" found in a quick search of the specification of Levine appear in col. 6, line 55; col. 11, lines 6, 11, 16, 36 and 62; and col. 12, line 15. None of the previously mentioned references to "detect" refer to "detecting the speech synthesizer". Instead, the use of "detect" in Levine refers respectively to subjects as follows: "writes", "a character", "data written", "attention character", "writes", "failures" and "character." Again, there is no mention of "detecting the speech synthesizer."

The Examiner responded to the above argument in the Advisory Action of 4/11/2007 that "[i]f an administration device is not recognized, no speech is outputted (col. 5, lines 27-35, col. 6, lines 2-6 and col. 12 .ines [sp] 17-28" and "as known in the art the term 'recognizing' as used in the reference means detecting." Once again, no reference is made to detecting a speech synthesizer in the referenced sections of Levine. It is submitted that Levine may output speech signals whether or not a synthesizer is connected. Levine does not teach the public either way. Therefore, Levine could not teach detecting a speech synthesizer.

In addition to the argument above, as required by claim 1, the BIOS of Applicant's invention performs a translation of display information to a data pattern, which data pattern is provided to a speech synthesizer. In contrast, Levine teaches, at column 5, lines 27-46, and column 6, lines 1-4, that the display information, such as data issued from the BIOS 3 and normally directed to a display adapter and local video display, is provided directly (i.e., in non-translated form) to an administration adapter 10. In direct contrast to Applicant's invention as claimed in claim 1, no translation of the data is performed by the BIOS prior to its being provided to the administration adapter.

In view of the foregoing, It is apparent that Shin and Levine independently and in combination fail to teach every element of independent claim 1. It is therefore impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is defective.

Thus, independent claim 1, as well as claims 2, 3 and 6-11 dependent therefrom, under 35 U.S.C. §103(a) is not supported and should be withdrawn and the claims allowed.

Claims 12-15, 18-24 and 27-29 include limitations similar to those of claims 1-3 and 6-11; therefore, for at least the same reasons as set forth above with reference to claim 1, the rejection of claims 12-15, 18-24 and 27-29 under 35 U.S.C. §103(a) should be withdrawn and those claims allowed.

As the PTO recognizes in MPEP §2142:

> The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

> [a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

> In addition, MPEP 2143.03 states "[t]o establish *prima facie* obviousness of a claimed invention, *all the claim limitations must be taught or suggested by the prior art*." Emphasis added and citation omitted.

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However as shown above, the references, alone, or in combination, do not teach a serial speech synthesizer and a computer system including a basic input output system (BIOS) configured to provide a translation from display information to a data pattern output via a serial port in the system for generating an audible output, wherein in response to detecting the speech synthesizer, the BIOS translates the information to a data pattern, which data pattern is provided to the speech synthesizer, the speech synthesizer coupled to the serial port and configured to reproduce the data pattern with the audible output.

This rejection relies on references that do not teach or suggest the claimed combination of elements. In short, Shin discloses a computer and control method, but, as conceded by the Examiner in the Office Action dated 2/08/2007, "Shin et al. does not teach a serial speech synthesizer, detecting the speech synthesizer, nor the synthesizer coupled to the serial port" as required by independent claims 1, 12, and 21. Levine discloses an apparatus and method for

remote administration of a PC-server, but as also conceded by the Examiner in the Advisory Action dated 4/11/2007, the Examiner "does not disagree that Levine et al. may not explicitly recite 'detecting'" the speech synthesizer as required by independent claims 1, 12, and 21.

Other reasons for the patentability of the pending claims have been previously presented and will be maintained should the filing of an appeal brief become necessary.

Respectfully submitted,

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